

Appln No. 09/651,389
Amdt date March 23, 2004
Reply to Office action of December 23, 2003

REMARKS/ARGUMENTS

By this Amendment, Applicants have amended claims 1 and 5 and have canceled claim 6. Therefore, claims 1-5 and 7-23 are pending after this amendment. Applicants respectfully request reconsideration, reexamination and allowance of this application.

The Examiner has rejected claim 4 under 35 U.S.C. §112, second paragraph as allegedly being indefinite. Applicants respectfully request that the Examiner withdraw the rejection. The term "about" used in the claim does not indefinite because the limitations relate to dimensions concerning width that may readily be measured by a measuring device. See MPEP 2173.05(b) (A) entitled "About" and cases cited therein. Accordingly, the rejection should be withdrawn.

The Examiner has rejected claims 1, 2 and 5-23 under 35 U.S.C. §102(b) as being anticipated by Davis et al., U.S. Patent 5,825,996. Applicants have amended claim 1 to include the limitation of "printing said information, wherein said information comprises postage information including a FIM." The Davis reference pertains to a system for printing greeting cards and the like, in which a special purpose paper having perforations enables printing that appears to go to the edge of the sheet because the user can print the sheet and then tear the sheet at the perforations. See Davis, FIGs. 2-7 and corresponding description. Davis's system does not relate to postal information, nor does it require a FIM for greeting cards, as FIMs are conventionally used on certain mail pieces, for example, pursuant to certain Postal Service guidelines and

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regulations. As Davis fails to disclose a step of the claim, the 102(b) rejection cannot stand. Applicants request therefore that the rejection to claim 1 be withdrawn. As claims 2 and 4 depend on claim 1, Applicants respectfully request that the Examiner withdraw the corresponding rejections to these claims as well.

Applicants have amended claim 5 to include the limitations of dependent claim 6, which Applicants have now canceled. Accordingly, claim 5 includes the following limitation, previously in claim 6, which reads: wherein the step of determining said printer offset comprises sending a print job having one or more patterns to said printer and determining said printer offset as a function of how said patterns print on a test envelope. According to the Examiner, this step is disclosed by Davis at col. 7, lines 57 through col. 8, line 5, and at col. 9, lines 10-40. However, in the cited sections, Davis appears to disclose the actual text of preprinted instructions that are printed on the special perforated print stock used with Davis's system and a print actuating scheme for printing on both sides of the special stock. There is no disclosure of a test envelope and no disclosure of sending a print job having one or more patterns to said printer and determining said printer offset as a function of how the patterns print on the test envelope. Accordingly, as Davis fails to disclose a step recited in claim 5, Applicants request the Examiner withdraw the rejection of this claim, as well as the rejection of claim 7 which depends upon claim 5, under 35 U.S.C. §102(b).

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With respect to claims 8 and 17, Davis fails to disclose the claimed combinations, including for example, in claim 8, the recited steps of "querying one or more databases, containing set up data on one or more printer drivers, to determine set up data for a user's printer; and performing a printer configuration test to determine the set up data for the user's printer as a function of said query ..." Claim 17 contains similar limitations. Accordingly, the rejections of claims 8 and 17 should be withdrawn. As claims 9-16 depend upon claim 8 and claims 18-23 depend upon claim 16, Applicants respectfully request that the rejections of these claims be withdrawn as well.

The Examiner has rejected claim 3 under 35 U.S.C. Section 103(a) as being unpatentable over Davis in view of Miller et al., U.S. Patent 6,461,063. Applicants respectfully request that the rejection be withdrawn. According to 35 U.S.C. Section 103(c):

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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Here, the subject matter of the Miller reference qualifies as prior art under 35 U.S.C. §102(e). The subject matter of the Miller reference and the claimed invention were either owned by or subject to an obligation of assignment to Stamps.com, Inc., Santa Monica, California, at the time the invention was made. Accordingly, the subject matter of Miller is not available under Section 103(a) to preclude patentability of the claimed invention, and the rejection of claim 3 should be withdrawn.

Based on the foregoing, Applicants respectfully request allowance of pending claims 1-5 and 7-23, and early issuance of a Notice of Allowance.

Respectfully submitted,
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